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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,923	09/30/2003	Michael J. Dougherty	200304427-2	5162

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[REDACTED] EXAMINER

CERULLO, JEREMY S

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

2112

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/674,923	DOUGHERTY ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Jeremy S. Cerullo	2112

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 19 May 2005.  
 2a) This action is FINAL.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1, 10, 20 and 25-33 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 1 and 27 is/are allowed.  
 6) Claim(s) 20, 25, 26 and 28-33 is/are rejected.  
 7) Claim(s) \_\_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 30 September 2003 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. <u>20050811</u> .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

**DETAILED ACTION**

1. Claims 1, 10, 20, and 25-33 are pending in the following action.

***Response to Arguments***

2. In view of the appeal brief filed on 19 May 2005, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



REHANA PERVEEN  
PRIMARY EXAMINER  
8/18/05

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 25-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,886,104 ("McClurg" et al.).

5. As for Claim 26, McClurg discloses a computer system comprising a device having power available therein (Figure 1, Docking Station 140; Column 4, Lines 20-40 discusses that the scanner receives power over USB from the docking station), a laptop computer (interpreted as a portable device capable of processing information, in this case hand-held fingerprint scanner 102 in Figure 1; Column 5, Lines 12-16) coupled to the device (docking station) by way of a Universal Serial Bus, and wherein the laptop computer (fingerprint scanner) is powered by the device (docking station) across the power lines of the communication bus (See Column 3, Lines 28-39 and Column 4, Lines 20-40). While McClurg does not disclose separate modes of operation, there is no requirement that a "first" mode and a "second" mode be exclusive. McClurg discloses the limitations of both of the claimed modes (operating under USB and the powering of the laptop over the communication bus) as occurring concurrently.

6. As for Claim 25, McClurg discloses all of the limitations inherited from Claim 26. McClurg also discloses that the device comprises a docking station. See Figure 1, Docking Station 140.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg in view of U.S. Patent No. 6,178,514 ("Wood").

10. As for Claim 10, McClurg teaches a computer system comprising a laptop computer (interpreted as a portable device capable of processing information, in this

case hand-held fingerprint scanner 102 in Figure 1; Column 5, Lines 12-16), adapted to dock to a docking station (Figure 1, Item 140) by way of a USB interface (Figure 1, Item 130; Column 3, Lines 28-39). McClurg teaches powering the laptop computer (fingerprint scanner) over the USB interface, but not with a voltage in excess of five volts. However, Wood teaches a system in which a USB device that requires a voltage higher than 5 volts can still be powered by the USB interface (See Figures 7 and 9; Column 18, Lines 30-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the boosting circuitry of Wood in the system of McClurg in order to allow for powering of a device that requires voltages in excess of 5 volts, such as a fingerprint scanner with a CCD camera instead of a CMOS camera (Column 4, Lines 20-40).

11. As for Claim 20, McClurg teaches a docking station (Figure 1, Item 140) for mating with a laptop computer (interpreted as a portable device capable of processing information, in this case hand-held fingerprint scanner 102 in Figure 1; Column 5, Lines 12-16) comprising a USB interface (Figure 1, Item 130; Column 3, Lines 28-39). McClurg teaches powering the laptop computer (fingerprint scanner) over the USB interface, but not with a voltage in excess of five volts. However, Wood teaches a system in which a USB device that requires a voltage higher than 5 volts can still be powered by the USB interface (See Figures 7 and 9; Column 18, Lines 30-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the boosting circuitry of Wood in the system of McClurg in order to allow for

powering of a device that requires voltages in excess of 5 volts, such as a fingerprint scanner with a CCD camera instead of a CMOS camera (Column 4, Lines 20-40).

12. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg and Wood as applied to Claim 10 above, and further in view of U.S. Patent No. 5,884,049 ("Atkinson"). As discussed above, Wood teaches a system in which a USB device that requires a voltage higher than 5 volts can still be powered by the USB interface (See Figures 7 and 9; Column 18, Lines 30-61). However what voltage is actually required would depend on the exact type of device connected to the docking station. According to McClurg, it may be five or twelve volts depending on the type of camera in the scanner (Column 4, Lines 20-40). Neither McClurg nor Wood teach that the voltage supplied is substantially 18 volt. However, Atkinson teaches that power provided to a laptop computer through an AC/DC converter (sufficient power to charge the battery) would be in the range of 8-18 volts. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the power to a laptop in the method taught by McClurg and Wood with a voltage in the range as taught by Atkinson in order to provide adequate power a laptop computer.

13. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg and Wood as applied to claim 10 above, and further in view of U.S. Patent No. 6,119,237 ("Cho"). McClurg and Wood teach all of the limitations inherited from Claim 10, but they do not teach shutting off power to the communication bus when the

computer is detached from the docking station. However, Cho teaches a method for shutting off a power source for powering a laptop from a docking station when the laptop disconnects from the docking station (Figure 7; Column 9, Lines 19-38). It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the method for disconnecting power as taught by Cho within the method of McClurg and Wood in order to prevent electronic damage or data loss that may occur if the device is improperly docked (Cho: Column 2, Lines 13-26).

14. Claims 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg in view of U.S. Patent No. 6,009,363 ("Beckert" et al.)

15. As for Claim 30, McClurg teaches a computer system comprising a laptop computer (interpreted as a portable device capable of processing information, in this case hand-held fingerprint scanner 102 in Figure 1; Column 5, Lines 12-16), adapted to dock to a docking station (Figure 1, Item 140) by way of a USB interface (Figure 1, Item 130; Column 3, Lines 28-39). McClurg teaches powering the laptop computer (fingerprint scanner) over the USB interface. McClurg does not teach that his device powers downstream devices. However, Beckert teaches the use of a USB hub, capable of transferring data and power to downstream devices. Beckert also teaches that the USB hub can be integrated into a USB device. See Column 5, Line 63 – Column 6, Line 6. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the USB hub of Beckert in the device of McClurg in order to

allow for the powering of downstream devices that may be needed in conjunction with the fingerprint scanner, such as USB lights.

16. As for Claim 31, McClurg teaches powering the laptop computer (fingerprint scanner) by a docking station over the USB interface. See Figure 1, Item 130; Column 3, Lines 28-39.

17. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg and Beckert as applied to claim 30 above, and further in view of Wood. McClurg teaches all of the limitations inherited from Claim 30. McClurg also teaches powering the laptop computer (fingerprint scanner) over the USB interface, but not with a voltage in excess of five volts. However, Wood teaches a system in which a USB device that requires a voltage higher than 5 volts can still be powered by the USB interface (See Figures 7 and 9; Column 18, Lines 30-61). It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the boosting circuitry of Wood in the system of McClurg in order to allow for powering of a device that requires voltages in excess of 5 volts, such as a fingerprint scanner with a CCD camera instead of a CMOS camera (Column 4, Lines 20-40).

18. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over McClurg, Beckert, and Wood as applied to claim 32 above, and further in view of U.S. Patent No. 5,884,049 ("Atkinson"). As discussed above, Wood teaches a system in which a USB device that requires a voltage higher than 5 volts can still be powered by

the USB interface (See Figures 7 and 9; Column 18, Lines 30-61). However what voltage is actually required would depend on the exact type of device connected to the docking station. According to McClurg, it may be five or twelve volts depending on the type of camera in the scanner (Column 4, Lines 20-40). Neither McClurg, Beckert, nor Wood teach that the voltage supplied is substantially 18 volt. However, Atkinson teaches that power provided to a laptop computer through an AC/DC converter (sufficient power to charge the battery) would be in the range of 8-18 volts. It would have been obvious to one of ordinary skill in the art at the time of the invention to have provided the power to a laptop in the method taught by McClurg, Beckert, and Wood with a voltage in the range as taught by Atkinson in order to provide adequate power a laptop computer.

***Allowable Subject Matter***

19. The following is a statement of reasons for the indication of allowable subject matter:

20. In light of the applicant's arguments, Claims 1 and 27 are considered to contain allowable subject matter, particularly the limitation in Claim 1 "wherein the device determines if the laptop is capable of being powered across the power lines of the communication bus by communication with the laptop across the power lines of said communication bus." This limitation is not present in the prior art of record.

**Conclusion**

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 5,884,086; U.S. Patent No. 6,633,932; U.S. Patent No. 6,184,652; and U.S. Patent No. 6,011,486.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeremy S. Cerullo whose telephone number is (571) 272-3634. The examiner can normally be reached on Monday - Thursday, 7:00-4:30; Alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rehana Perveen can be reached on (571) 272-3676. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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